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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,485	09/15/2000	Nobuya Sato	197129US0PCT	7267
22850	7590	10/15/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			GHALI, ISIS A D	
			ART UNIT	PAPER NUMBER

1615

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/623,485

Applicant(s)

SATO ET AL.

Examiner

Isis Ghali

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

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☒ Responsive to communication(s) filed on 27 July 2004.

a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

☒ Claim(s) 1,2,7-10 and 24-26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, 7-10 and 24-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Specification Papers

☐ The specification is objected to by the Examiner.

☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

☐ Notice of References Cited (PTO-892)

☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date. \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The receipt is acknowledged of applicant's amendment, filed 07/27/2004.

Claim 3 have been canceled, claims 1, 2, 7-10, 24-26 are included in the prosecution.

**The following new ground of rejections are necessitated by applicants' amendment:**

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 7-10, 24-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment of the claims to recite "organic UV light absorbing compounds" has introduced a new matter to the claims because nowhere in the specification applicants disclosed "organic UV absorber"

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and the section of the specification that applicants are referring to for support does not include the term "organic ".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 7-10 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 24, the expressions "cooling agent" and "warming agent" do not set out the metes and bounds of the claims. Recourse to the specification does not define the expressions. The expressions "hair-growth regulating agent", "hair growing agent", and "hair nourishing agent" do not set out the metes and bounds of the claims. Recourse to the specification does not define the expressions to clarify the difference between these agents because they overlap in definitions and functions. Clarification is requested.

Regarding claims 7-10, the claims further add limitations to claim 1 that has closed language "consisting essentially of". Claims should be rewritten in an independent form to include all of the limitations of the base claim.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 2, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-216809 ('809).

JP '809 teaches a cosmetic sheet having easy handability and applicable to the skin giving the attached area excellent benefit and excellent feeling free from stickiness to the skin (abstract). The sheet comprises polyvinyl alcohol especially vinylon (thermoplastic resin); oily ingredient including glycerol and fatty acid esters, natural oils, glyceride derivative which is hydrogenated natural oil, wax, paraffin microcrystalline wax, ceresin, and vaseline; and active agent selected from UV ray absorbent such as p-aminobenzoic acid glycerol, whitening agent, astringent, and anti-wrinkles agents

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(paragraphs 0016, 0024-0026, 0028, 0037, 0039, 0051, 0052). The sheet is made by blending the ingredient during the production of the sheet (paragraph 0059).

The reference does not teach the amounts of the different active agents, thickness of the sheet, or the modulus. It is within the skill in the art to select the amounts and thickness in order to achieve the required beneficial effect and physical properties, such as the modulus, according to specific intended use. Thus, the claimed amounts do not impart patentability to the claims since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a sheet comprising thermoplastic resin, active agent, and oily ingredient as disclosed by the reference, and manipulate the amount of the ingredients and the thickness of the sheet in order to achieve the desired beneficial effects and physical properties of the sheet according to the intended use or site of application, with reasonable expectation of having a cosmetic sheet with desirable modulus that deliver active agents to the skin or hair with success.

8. Claims 1, 2, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 05-188527 ('527).

JP '527 teaches a cosmetic sheet used for conditioning and beautifying the skin that has excellent safety and stability (abstract). The sheet comprises polyhydric alcohol, specially glycols such as low molecular weight PEG or propylene glycol, or

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polyacrylate; active agent such as anti-inflammatory agent, whitening agent, or circulation promoting agent, anti-oxidant (anti-aging), UV absorbent such as p-aminobenzoic acid ester or salicylate; and fatty ingredient such as sorbitan ester, glycerol esters or fatty acid ester (paragraphs 005, 0010, 0012, 0014, 0016, 0017, 0019). The method of making the sheet comprises the step of blending the ingredients and shaping the sheet (paragraphs 0021).

The reference does not teach the amounts of the different active agents, thickness of the sheet, or the modulus. It is within the skill in the art to select the amounts and thickness in order to achieve the required beneficial effect and physical properties, such as the modulus, according to specific intended use. Thus, the claimed amounts do not impart patentability to the claims since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a sheet comprising thermoplastic resin, active agent, and oily ingredient as disclosed by the reference, and manipulate the amount of the ingredients and the thickness of the sheet in order to achieve the desired beneficial effects and physical properties of the sheet according to the intended use or site of application, with reasonable expectation of having a cosmetic sheet with desirable modulus that deliver active agents to the skin or hair with success.

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9. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of JP '809 or JP '527 in view of US 6,022,550 ('550).

The teachings of the references are discussed above, however, the references do not teach the thermoplastic elastomer claimed in claims 7-10.

US '550 teaches a sheet having shape-memory effect and excellent chemical resistance comprising polystyrene-based elastomer comprising hard styrene phase and flexible phase comprising diene compound such as polybutadiene (abstract; col.3, lines 56-61; col.4, lines 1-18, 26-33; col.5, lines 55-59).

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide sheet comprising thermoplastic resin, active agent, and oily ingredient as disclosed by any of JP '809 or JP '527, and add the thermoplastic elastomer having hard styrene phase and flexible polybutadiene phase as disclosed by US '550, motivated by the teaching of US '550 that the sheet comprising this elastomer has shape-memory effect and excellent chemical resistance, with reasonable expectation of having a sheet comprising thermoplastic resin, active agent, oily ingredient and thermoplastic elastomer that can be used for medical purposes.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,880,044 teaches that vinylon is a thermoplastic resin, col.3, lines 45-47.



### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 7-10 and 24-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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